REMARKS

The Office Action dated April 14, 2005 has been carefully considered. Claim 1 is pending in the present application. Claims 50-89 have been withdrawn. Claim 1 has been amended to more particularly point out and distinctly claim the present invention. The amendment is fully supported by the originally filed specification at, for example, page 5, line 17; and page 7, lines 5-13. No new matter has been introduced. Reconsideration of the present application in view of the claim amendment and the following remarks is respectfully requested.

I. CLAIM REJECTION UNDER 35 U.S.C. § 103

Claim 1 is rejected under 35 U.S.C. § 103 as allegedly being made obvious by U.S. Patent No. 6,488,701 to Nolting *et al.* ("Nolting"). This rejection is respectfully traversed.

Claim 1 recites "An expandable intraluminal stent comprising a metal main body portion having a first end portion, a second end portion, a middle portion having a surface, and a flow passage defined therethrough, wherein the first end portion has at least one surface having a biocompatible coating directly thereon, wherein the biocompatible coating comprises a polymer or a drug, and wherein the middle portion surface is free of the biocompatible coating."

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). "When obviousness is based on a particular prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of the reference." *B.F. Goodrich Company v. Aircraft Braking Systems Corporation*, 72 F.3d 1577, 1582 (Fed. Cir. 1996).

Nolting does not disclose or suggest "an expandable intraluminal stent comprising a metal main body portion having a first end portion, a second end portion, a middle portion having a surface, and a flow passage defined therethrough, at least a portion of the first end portion having at least one surface having a biocompatible coating directly thereon, wherein the biocompatible coating comprises a polymer or a drug, and *wherein the middle portion surface is free of the biocompatible coating*" as recited in claim 1, as amended herein.

Nolting discloses a stent-graft assembly comprising a stent having at least one support member wherein "[s]ome or all of the support member or members comprise a coating which substantially encapsulates the coated support member or members" and "the stent-graft

includes an ultra-thin membrane or covering which is attached to the coating." (Col. 5, lines 32-38).

Unlike the present invention, Nolting does not disclose or suggest that the middle portion surface of its stent is free of the coating on the surface of the end portion. In fact, Nolting teaches that the coating **20** that is disposed on the surface of the ends of its stent also covers the surface of the middle of Nolting's stent (*see* Figure 2 of Nolting). Fig. 2 of Nolting shows a stent (9) with a first coating on "some or all of the support members (11)," a thin membrane (21) over the first coating and a second coating (34) over the thin membrane on the distal portion of the stent. (Column 7, lines 35-57). Thus, by teaching that the coating **20**, which is on the surface of the ends of the stent, covers the surface of the middle of Nolting's stent, Nolting teaches away from the present invention where the middle portion surface of the stent is free of the coating that is on the surface of the first end portion of the stent as required by claim 1, as amended herein.

Although Nolting does not disclose or suggest a middle portion surface that is free of the biocompatible coating that is on the surface of the first end portion as required by amended claim 1, the Examiner stated that "it appears that the coating of Nolting would perform equally as well and is deemed to be a design consideration which fails to patentably distinguish over the prior art of Nolting." Office Action, page 4. However, according to MPEP § 2144.04, "'The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device.'" MPEP § 2144.04 *citing Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). As explained above, Nolting does not disclose or suggest a middle portion surface that is free of the biocompatible coating that is on a surface of an end portion of a stent. In addition, one skilled in the art would not find motivation or reason in the teachings of Nolting to modify Nolting's stent graft assembly to obtain the presently claimed invention.

Moreover, Applicant submits that any rejection of claim 1 under § 103 based on Nolting would indicate the improper use of hindsight gained from Applicant's own specification. Hindsight should be avoided in applying the nonobviousness requirement. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1 U.S.P.Q.2d 1593 (Fed. Cir. 1987), *cert. denied*, 481 U.S. 1052 (1987). Accordingly, the rejection is improper and Applicant requests withdrawal of the rejection.

Since all the claim limitations are not taught or suggested by Nolting, it is believed that claim 1 is patentable over Nolting. Accordingly, allowance of claim 1 is respectfully requested.

II. CONCLUSION

In light of the above amendments and remarks, it is believed that the rejection has been overcome and that the present application is in condition for allowance. Should the Examiner not agree with Applicant's position, then a personal or telephonic interview is respectfully requested to discuss any remaining issues and expedite the eventual allowance of the application.

Respectfully submitted,

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Enclosures